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09/500,174	02/08/2000	Yasuharu Katsuno	JA9-99-044	2214

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James E Murray  
69 South Gate Drive  
Poughkeepsie, NY 12601

EXAMINER

RAMOS FELICIANO, ELISEO

ART UNIT	PAPER NUMBER
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2687

DATE MAILED: 04/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/500,174

Applicant(s)

KATSUNO ET AL.

Examiner

Eliseo Ramos-Feliciano

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/

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 22 December 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on December 22, 2004 has been entered.

### ***Claim Objections***

2. **Claim 7** is objected to because of the following informalities: the recitation "personal information of the mobile station users personal interests and/or preferences" in lines 7-8 appears to mean --personal information of the mobile station users including personal interests and/or preferences--. Appropriate correction is required.

3. **Claim 1** is objected to because of the following informalities: in line 15 the deleted "[[and]]" should have been replaced by a comma (","). Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

4. *Previous 112-2nd rejection to claims 1 and 6 is withdrawn in view of Applicant's submission filed on December 22, 2004.*

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. **Claims 5 and 9** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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- a. **Claim 5** recites the limitation "that mobile station" in line 4. It is unclear what mobile station is being referred to since the claim, including its base claims, recites mobile stations in plural form. Does it mean --for detecting its own location--?
  - b. **Claim 9** recites the limitation "that mobile station" in line 10. It is unclear what mobile station is being referred to since the claim recites mobile stations in plural form. Does it mean --for detecting its own location--?
7. **Claim 1** is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
- a. Regarding **claim 1**, the phrase "such as" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d). (In order to overcome rejection, see suggestion for claim 7 above).

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. **Claims 1-13** are rejected under 35 U.S.C. 103(a) as being unpatentable over Kimoto et al. (US Patent Number 6,115,611).

Regarding **claims 1, 7 and, 11**, Kimoto et al. discloses a mobile communication system (see abstract) for calling one or more mobile stations (4; Figure 8) located within a designated

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communication area including location receipt and storage means (information center 5; database 52; *inter alia*; either singularly or in combination; as shown in Figure 8) for receipt and storage of the locations of the mobile stations transmitted to the location receipt and storage means by the mobile stations over a communication network (6, 7; either singularly or in combination) and the Internet (8). The system further includes designation accepting means (52a-53b; either singularly or in combination) for accepting the designation of the communication area based on the stored locations (e.g. CSID; see column 17, lines 28-39, column 31, lines 30-47, column 36, lines 17-26); mobile station selection means (5, 51; either singularly or in combination) for selecting the mobile stations to be called based on the accepted communication area and the stored locations of the mobile stations; and calling means (6, 5; either singularly or in combination), for calling the selected mobile stations to be called. Figure 8 illustrates the system. Figure 9 shows that the position information includes latitude and longitude; see also Figure 21, step S33. The location is detected by a GPS location detection means (position detecting unit) in the mobile station; see Figure 21, step S32; and column 3, lines 15-17, column 36, lines 54-60, column 37, lines 47-55, *inter alia*. Figures 19-20, step S25, show that the information center stores the position in the database. Figure 27, illustrates database 52, including position information 525. See columns 3-14 and 33.

In alternative embodiment, Kimoto et al. teaches that the system includes a personal information database means (52 – Figure 27: including 522 and/or 527) for personal information of the users of the mobile stations such as interests and/or personal tastes (for example “habit or hobby” – column 44, lines 53-58; also Figure 49). The selected mobile stations are called further

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based on this “habit or hobby” (the information service is customized to meet habit or hobby of the user – column 44, lines 43-58; also column 51, line 60 to column 52, line 6).

Therefore, it would have been obvious to combine both of Kimoto et al.’s embodiments described above because as the same Kimoto et al. suggests this feature largely contributes to improvement of the service (column 44, lines 57-58) and largely reduce the burden of maintenance and management (column 44, lines 50-52).

Regarding **claims 2-3**, Kimoto et al. discloses everything claimed as applied above (see claim 1). In addition, Kimoto et al. teaches that calls are placed in a designated time zone to one or more mobile stations located within a designated communication area. See column 40, lines 25-40, column 43, lines 24-49, and column 44, lines 34-43.

Kimoto et al. further teaches limiting the number of calls placed based on the personal information of the users of the mobile station (since the information is limited to fit user’s “habit or hobby” – column 44, lines 55-58; and because the information is also limited to a particular user that meets the required personal information – column 52, lines 2-5).

Regarding **claims 4-5**, Kimoto et al. discloses everything claimed as applied above (see claim 1). In addition, Kimoto et al. teaches a base station (6, Figure 8) and a “calling device” (combination inside INFORMATION CENTER 5, Figure 8). As explained above, each mobile station includes a GPS location detection means (position detecting unit), and a location notification means (position information transmitting unit); see Figure 21, step S32; and column 3, lines 15-17, column 36, lines 54-60, and column 37, lines 47-55.

With respect to **claims 6 and 8**, they are the analogous reciprocal system and method claims of system and method claims 1 and 7, respectively. Therefore, they are rejected for the

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same reasons above. With respect to **claims 9 & 12 and 10 & 13**, they are the corresponding recording medium (computer program) claims of system claims 1/5 and 6. Therefore, they are rejected for the same reasons above.

In addition, Kimoto et al. further suggests transmitting from one mobile (mobile terminal A) to another mobile station (mobile terminal B) information (e.g. A6) including the designation of said accepted communication area as claimed (Figures 37-39; in general columns 45-48, in particular column 46, lines 29-63). As depicted in Figure 37 transmission or communication is "direct" as claimed.

#### ***Response to Arguments***

10. Applicant's arguments filed December 22, 2004 have been fully considered but they are not persuasive.

Applicant's arguments are directed to the newly added features (underlined). This new features have been addressed and explained above.

#### ***Conclusion***

11. Any inquiry concerning this communication from the examiner should be directed to Eliseo Ramos-Feliciano whose telephone number is 571-272-7925. The examiner can normally be reached from 8:00 a.m. to 5:30 p.m. on 5-4/9 1st Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lester G. Kincaid, can be reached on (571) 272-7922.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ERF/erf  
April 1, 2005

  
4/1/05  
**ELISEO RAMOS-FELICIANO**  
**PATENT EXAMINER**